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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/892,695	07/15/97	GRAY	J 023070068930

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EXAMINER

CANELLA, K

ART UNIT

PAPER NUMBER

1642

27

DATE MAILED:

11/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/892,695

Applicant(s)

Gray et al

Examiner

Karen Canella

Group Art Unit
1642



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 26-28, 36, and 37 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 26-28, 36, and 37 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Response to Amendment

1. Please note that the examiner to which your application is assigned at the PTO has been changed.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 26 has been amended. Claim 41 has been canceled. Claims 26-28, 37 and 38 are under consideration.

New Claim Rejections


4. Claims 26-28 and 37 are rejected under 35 U.S.C. 102(a) as being anticipated by either Tanner et al (Clin Cancer Res, 1995, Vol. 1, pp. 1455-1461) or Tanner et al (Cancer Research, Aug 1996, Vol. 56, pp. 3441-3445). The instant claims are drawn to a method of screening cells comprising contacting a nucleic acid sample from a human patient with breast cancer to a probe which selectively hybridizes under stringent conditions to a target polynucleotide sequence **comprising** SEQ ID NO:9, and detecting the formation of a hybridization complex, wherein amplification of said target polynucleotide sequence indicates that the cell is a neoplastic cell. Additional embodiments include the nucleic acid sample as a metaphase spread or an interphase nucleus and the probe **comprising** the polynucleotide sequence as set forth as SEQ ID NO:9. The specification teaches in figure 3 that the target polynucleotide sequence **comprising** the genomic sequence of SEQ ID NO:9 is contained within the region of chromosome 20 spanned by the RMC20C001 probe. Tanner et al (Clin Cancer Res, 1995, Vol. 1, pp. 1455-1461) or Tanner et al (Cancer Research, Aug 1996, Vol. 56, pp. 3441-3445) disclose the RMC20C001 probe which comprises SEQ ID NO:9, as taught by figure 3 of the instant specification in a method of screening breast cancer cells comprising contacting a metaphase spread with the RMC20C001 probe to measure copy number of the 20q13 amplicon.

5. The provisional rejection of claims 36 and 37 under 35 U.S.C. 101 as claiming the same invention of claims 35 and 36 of co-pending Application No. 08/731,499 is maintained for reasons of record.
6. The provisional rejection of claims 26-28, 36 and 37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-26, 35-36 and 38 of co-pending Application No. 08/731,499 is maintained for reasons of record.
7. The provisional rejection of claims 26-28, 36 and 37 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-28, 37-38, 56-57 and 61-63 of co-pending Application No. 08/785,532 is maintained for reasons of record.
8. All other rejections and objections cited in Paper No. 24 are withdrawn.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.
Patent Examiner, Group 1642
November 6, 2000


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SUPERVISORY PATENT EXAMINER
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